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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,054	02/12/2007	Robert Eric Montgomery	P1087US04	3707
53096 7590 11/21/2008 DISCUS DENTAL, LLC 8550 HIGUERA STREET CULVER CITY, CA 90232				
EXAMINER				
PATEL, YOGESH P				
ART UNIT		PAPER NUMBER		
3732				
MAIL DATE		DELIVERY MODE		
11/21/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/568,054

Applicant(s)

MONTGOMERY, ROBERT ERIC

Examiner

YOGESH PATEL

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-101 is/are pending in the application.
- 4a) Of the above claim(s) 1-61 and 79-101 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 62-78 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-61, 98-101, drawn to a method of whitening teeth.

Group II, claim(s) 62-78, drawn to a liquid oral therapeutic dental compositions.

Group III, claim(s) 79-97, drawn to a therapeutic dental delivery device.

The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the special technical featured of the Group I invention is the particular second tooth whitening composition claimed therein while the special technical feature of the Group II invention is the particular moisture responsive gel carrier claimed therein. Since the special technical feature of the Group I invention is not present in the group II invention being claimed and the special technical feature of the group II invention is not present in the group I invention being claimed, unity of invention is lacking.

The inventions listed as Groups I and III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the special

technical featured of the Group I invention is the particular second tooth whitening composition claimed therein while the special technical feature of the Group III invention is the particular applicator claimed therein. Since the special technical feature of the Group I invention is not present in the group II invention being claimed and the special technical feature of the group III invention is not present in the group I invention being claimed, unity of invention is lacking.

The inventions listed as Groups II and III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the special technical feature of the Group II invention is the particular moisture responsive gel carrier claimed therein while the special technical feature of the Group III invention is the particular applicator claimed therein. Since the special technical feature of the Group II invention is not present in the group III invention being claimed and the special technical feature of the group III invention is not present in the group I invention being claimed, unity of invention is lacking.

During a telephone conversation with Nancy Quan on 11/06/2008 a provisional election was made without traverse to prosecute the invention of Group II, claims 62-78. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-61, 79-101 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 62-70, 72, and 75 are rejected under 35 U.S.C. 102(e) as being anticipated by Singh et al. (2003/0235549).

Singh discloses dental compositions including a moisture responsive gel carrier (e.g. hydrogel) comprise a moisture sensitive polymer (para [0029, 0031, 0035]), and water-soluble salts and a therapeutic agent (e.g. whitening agent and para [0007]). The "that increases in viscosity upon contact with moisture..." is not given any patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recited the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness, but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Singh further discloses thermally responsive polymers, such as methyl cellulose and ethyl cellulose ([0085]), pH sensitive polymer [0023] and hydrogen peroxide [0007,

00168]; carbamide peroxide and water [0174]); carboxypolymethylene, polyvinylpyrrolidone [0152].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 71, 73, 76-78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Singh as applied to claim 62 above.

Singh discloses the invention substantially as claimed except for the specifics of moisture responsive gel carrier and water soluble salt, e.g. sodium chloride. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to use the specific amount of moisture responsive gel since it has been held that discovering the optimum or workable ranges involves only routine skills in the art. *In re Aller*, 105 USPQ 233. Further, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use the amount of the gel based on how responsive the gel is needed. Accordingly, if one desires to make the gel less moisture responsive, then one of ordinary skill in the art at the time of the invention was made to realize to lower the amount of moisture responsive carrier. Further, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use

alternatives of water soluble salts (e.g. sodium chloride) for stabilizing purpose. Further, since methylcellulose and poly (oxyethylene)-poly block copolymer are art equivalent, one of ordinary skill in the art would have found obvious to substitute methylcellulose with poly (oxyethylene)-poly block copolymer.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to YOGESH PATEL whose telephone number is (571)270-3646. The examiner can normally be reached on 8:00 to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez can be reached on 571-272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Y. P./
Examiner, Art Unit 3732

/Ralph A. Lewis/
Primary Examiner, Art Unit 3732